

REMARKS

These amendments and remarks are being filed in response to the Office Action dated August 9, 2004. For the following reasons, this Application should be in condition for allowance the case passed to issue.

No new matter is introduced by this amendment. The amendment to claim 11 is supported by claims 13 and 14. The amendment to claim 21 is supported by claims 23 and 24.

Claims 11-18 and 21-28 are pending in this application. Claims 11 and 21 have been amended. Claims 1-10 and 19-20 are canceled.

Claim Rejections Under 35 U.S.C. § 103

Claims 11, 12, 15-18, 21, 22, and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. (U.S. Patent No. 6,020,045) taken in view of Arita et al. (U.S. Patent No. 5,976,714) and Goto (U.S. Patent No. 6,287,663). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the claimed invention and the cited prior art.

An aspect of the invention, per claim 11, is a magnetic recording medium comprising a non-magnetic substrate including at least one major surface having a contact start/stop (CSS) or landing zone and a data zone. The substrate surface in the CSS or landing zone comprises an embossed pattern of recesses comprising a plurality of rectangularly-shaped or sinusoidally-shaped recesses.

Another aspect of the invention, per claim 21, is a disk drive comprising a magnetic recording medium. The magnetic recording medium comprises a non-magnetic substrate including at least one major surface having a contact start/stop (CSS) or landing zone and a data zone. The substrate surface in the CSS or landing zone comprises an embossed pattern of recesses comprising a plurality of rectangularly-shaped or sinusoidally-shaped recesses.

The Examiner asserted that Chen et al. substantially disclosed the claimed magnetic recording medium including a non-magnetic substrate and a textured pattern. The Examiner considered the “embossed” limitation to be a process limitation that would not be given weight unless shown to produce a patentable article. The Examiner alleged that Arita and Goto recognizes the equivalence of recesses and protrusions as texture produced by pulsed laser irradiation. The Examiner concluded that it would have been obvious to modify the texture to optimize performance with a given head design to optimize the texture in each zone.

Chen et al., Arita et al., and Goto, whether considered in combination, or alone, do not suggest the claimed magnetic recording medium or disk drive. Chen et al., Arita et al., and Goto do not suggest the substrate surface in the CSS or landing zone comprises an embossed pattern of recesses comprising a plurality of rectangularly-shaped or sinusoidally-shaped recesses, as required by claims 11 and 21.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The Examiner has not shown any suggestion in either Chen et al., Arita et al., or Goto to modify the substrate of the magnetic recording medium of Chen et al. so that its surface comprises an embossed pattern of recesses comprising a plurality of rectangularly-shaped or sinusoidally-shaped recesses, as required by claims 11 and 21.

The dependent claims are allowable for at least the same reasons as the independent claims from which they depend and further distinguish the claimed invention. For example, claims 16 and 26 further require that the substrate comprises glass, ceramic, and glass-ceramic and further includes a glass or glass-like layer on at least the substrate surface in the CSS or landing zone, and the glass or glass-like layer is derived from a sol-gel layer and including a surface with the pattern of recesses formed therein. Claims 17 and 27 further require that the substrate surface in the data zone comprises an embossed servo pattern. Claims 18 and 28 further require a stack of thin film layers formed over at least the substrate surface in the data zone and the stack of layers include at least one ferromagnetic recording layer. The prior art does not suggest the claimed magnetic recording medium and disk drive with these additional limitations.

Allowable Subject Matter

Claims 13, 14, 23, 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Applicants gratefully acknowledge the indication of allowable subject matter. In accordance with the Examiner's recommendation, claim 11 was amended to include limitations from claims 13 and 14, and claim 21 was amended to include limitations from claims 23 and 24. Applicants submit that in view of these amendments claims 11-18 and 21-18 are allowable.

In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including

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extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in cursive script, reading "Bernard P. Codd".

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